

## **SUMMARY**

The following Remarks are responsive to the Office Action dated December 1, 2006. In the Office Action, claims 1-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/35242 in view of "Switchable Privacy Glass." Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/35242 in view of "Switchable Privacy Glass." Claims 15-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/35242 in view of "Switchable Privacy Glass." Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over "Switchable Privacy Glass" in view of WO 00/35242. Upon entry of this Response, claims 1-20 remain pending in this application. Entry and consideration of this Response are respectfully requested.

### **Response to Rejections Under 35 U.S.C. § 103(a):**

In the Office Action, claims 1-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/35242 in view of "Switchable Privacy Glass." Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/35242 in view of "Switchable Privacy Glass." Claims 15-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/35242 in view of "Switchable Privacy Glass." Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over "Switchable Privacy Glass" in view of WO 00/35242. Applicants traverse these rejections.

The latest nonfinal office action in the present application was filed by the Examiner to address the Response Applicants filed September 19, 2006. In the September 19, 2006 Response, Applicants properly traversed the Examiner's assertion of obviousness based on the combination of WO 00/35242 in view of "Switchable Privacy Glass." Applicants detailed that a prima facie case of obviousness had not been presented since there was no motivation to

combine WO 00/35242 and “Switchable Privacy Glass” without reference to Applicants’ specification. Accordingly, the burden was shifted back to the Examiner to provide a proper reason to combine that was either in the references themselves or readily available in the prior art. Instead, the Examiner issued another office action that maintained the rejections based on the combination of WO 00/35242 in view of “Switchable Privacy Glass” and added additional rejections based on the combination of “Switchable Privacy Glass” in view of WO 00/35242. The Examiner provided no basis in the references themselves for either maintaining the original rejection or for adding the new rejection, which is based on the same references reversed. The only addition to the maintained rejections were several speculative comments of areas that one may be inspired to utilize the alleged inventions described in either WO 00/35242 or “Switchable Privacy Glass.” This clearly fails to meet the burden described in section IV of MPEP 2143.01, entitled “FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS.” Section IV states that even if the prior art references teach all aspects of the invention individually, the Examiner fails to meet the burden of prima facie obviousness when there is no objective reason to combine the references. The prior art asserted here fails to provide all aspects of the claimed invention and, even if it did, the reasons proposed by the Examiner for such combination fail entirely to meet the burden of prima facie obviousness. Further, Section V of MPEP 2143.01, which is entitled “THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE,” details that the combination proposed cannot render the prior art unsatisfactory--this is precisely what would occur if the references asserted in either combination

asserted were combined. A vibratory display panel would be unsatisfactory for displaying images--the purpose of "Switchable Privacy Glass."

Without establishing a prima facie case of obviousness, the maintenance of the rejections traversed and the imposition of additional rejections based on the same art does little but waste Applicants' time. These rejections clearly are unfounded and should not have been made or maintained without the requisite motivation. Accordingly, since Applicants are apparently in a revolving process of rejections without basis, and since these claims have been twice rejected, a Notice of Appeal is being filed concurrently herewith to end this cycle of unfounded rejections.

**Reiteration of response to rejections and contra posed response to new rejections:**

As detailed in the Response filed September 19, 2006, WO 00/35242 provides a loudspeaker that vibrates a pane of glass to produce acoustic output. Every window shown in the figures of WO 00/35242 includes a vibratory speaker element, and there is no motivation in the cited art to replace a window of WO 00/35242 with a "Switchable Privacy Glass" window. Assuming *arguendo* that such motivation existed, the combination would yield a switchable window with vibratory exciters. This is nonsensical. One of ordinary skill would not be motivated to create a vibrating glass speaker. Further, one would not be motivated to create a vibratory display pane to display images – since the images would vibrate. Clearly, absent the present invention's teachings, no motivation exists in these references that would teach or suggest the proposed combination.

Further, the proposed combination of WO 00/35242 with "Switchable Privacy Glass" simply is not properly supported. Specifically, the Examiner has not pointed to any suggestion or motivation to combine these two references. In fact, there is not, and would not have been at the time the invention was made, any motivation to make such a combination. WO 00/35242

teaches only a loudspeaker and fails entirely to teach or suggest a switchable glazed window that is excited by vibration to display an image. “Switchable Privacy Glass” teaches only switchable glazed windows and fails entirely to teach or suggest a speaker system. The Examiner is not allowed to pick elements of disparate teachings to assert that an invention is obvious. Further, such suggestion, especially when made while combining disparate arts, cannot be gleaned from Applicants’ specification.

As to the new rejections of claims 1-20 based on “Switchable Privacy Glass” in view of WO 00/35242, the analysis is quite similar. Specifically, “Switchable Privacy Glass” provides glass that can switch to receive images projected thereupon. WO 00/35242 provides a loudspeaker that vibrates a pane of glass to produce acoustic output. Every window shown in the figures of WO 00/35242 includes a vibratory speaker element. Even if supported by a motivation to replace a “Switchable Privacy Glass” window with a WO 00/35242 window (no such motivation is shown or taught), the combination would yield a switchable window with vibratory exciters. This is nonsensical. One of ordinary skill would not be motivated to create a vibratory display pane to display images and sound – since the images would vibrate. Clearly, absent the present invention’s teachings, no motivation exists in these references that would teach or suggest the proposed combination.

Further, the proposed combination of “Switchable Privacy Glass” with WO 00/35242 simply is not properly supported. Specifically, the Examiner has not pointed to any suggestion or motivation to combine these two references. In fact, there is not, and would not have been at the time the invention was made, any motivation to make such a combination. “Switchable Privacy Glass” teaches only switchable glazed windows and fails entirely to teach or suggest a speaker system. WO 00/35242 teaches only a loudspeaker and fails entirely to teach or suggest a

switchable glazed window that is excited by vibration to display an image. The Examiner is not allowed to pick elements of disparate teachings to assert that an invention is obvious. Further, such suggestion, especially when made while combining disparate arts, cannot be gleaned from the Applicants' specification.

For at least the foregoing reasons, the rejections under 35 USC §103(a) are improper and should be withdrawn. The invention is not obvious in view of the prior art, and the pending claims are thus allowable over such art.

### **CONCLUSION**

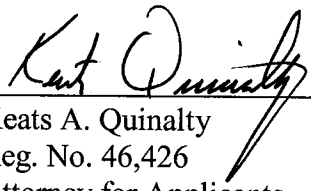
Claims 1-20 are allowable and a notice to such effect is earnestly solicited. Should the Examiner have any questions or comments regarding the foregoing Response, she is invited and urged to telephone the undersigned attorney.

### **AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees that may be required for the timely consideration of this Response under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account No. 09-0528.

Date: 3/1/07

Respectfully submitted,

  
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